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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,193	12/15/2003	Bobby E. Rogers	16491-008002	5504
20985	7590	07/05/2005	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			CHAN, WING F	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/737,193

Applicant(s)

ROGERS ET AL.

Examiner

Wing F. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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1. Applicants' continuation claim to parent application 09/841,133 is noted. This application repeats a substantial portion of prior Application No. 09/841,133, filed 4/23/01, and adds and claims additional disclosure not presented in the prior application. Therefore the present application constitutes a continuation-in-part of the prior application, and should be claimed as a continuation-in-part to be correct.

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: it should claim benefit to the parent application as a C-I-P.

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

The first sentence of the application should state it is a continuation in part to the prior application and not a continuation.

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4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,665,385. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are directed to the same invention albeit in obvious alternate language.

For example, consider patent claim 1 and present claim 1

<u>Patent claim 1:</u>	<u>Present claim 1:</u>
A medical monitoring system, comprising:	A medical monitoring system comprising:
a sensor system including a sensor associated with a patient;	a sensor unit configured to sense one or more physiological characteristics of a patient;
a remote monitoring unit comprising a microprocessor in communication with the	a monitoring unit in communication with the sensor unit and

sensor system, and a portable-monitoring-unit transceiver system in communication with the microprocessor,	operable to communicate information relating to the sensed physiological characteristics to a central unit;
the portable-monitoring-unit transceiver system comprising a land-line telephone transceiver, a primary wireless-network transceiver, and a third-network transceiver; and the microprocessor includes a processing routine that transmits a data set matches the available communication link.	and a plurality of communications channels operable to communicate between the monitoring unit and the central unit, the monitoring unit operable to specify for transmission a data set that is tailored to a particular communications channel to be used to communicate the information relating to the sensed physiological characteristics to the central unit.

As can be seen from the above comparison, present claim 1 is obvious to patent claim 1 since both claims are directed to the same invention and are not patentably distinct from each other. Although the language of present claim 1 is different over patent claim 1 such changes in language is deemed obvious over patent claim 1. As disclosed the sensors are to provide physiological characteristics of a patient to a remote location, and the data is communicated either over the landline, wireless transceiver and that the data set is selected to match the available communication link

used as is defined in the specification. Therefore, in view of the definition of the patentee, the two claims are obvious over each other and the present claim 1 uses obvious alternate languages over patent claim 1 and as such the claims are not patentably distinct from each other and in the absence of a terminal disclaimer would result in possible harassment by multiple assignees.

Although only exemplary claim 1 is discussed above, the above analysis is applicable to the other claims. Furthermore, since the claim is in comprising format it is open to cover other non-claimed features; the features of the dependent claims which are dependent on the other independent claims are disclosed in the patent and covered by the comprising format of patent claim.

Also, since the specification of the patent discloses selecting the communication link based on the availability of the communication link, to select the communication link using predetermined criteria, parameters, such as availability, bandwidth, quality, latency, cost and reliability as is now claimed would have been encompassed by and obvious over the term "availability" as is used in the patent. Therefore, the present claims are not patentably distinct from the patent claims and in the absence of a terminal disclaimer would result in possible harassment by multiple assignees.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Spaur et al (US PAT. NO. 6,122,514) discloses communications channel selection.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wing F. Chan whose telephone number is 571-272-7493. The examiner can normally be reached on Monday to Friday from 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 571-272-7499. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Wing F. Chan  
Primary Examiner  
Art Unit 2643

6/23/05